

informality be reconsidered and withdrawn.

Applicants acknowledge with appreciation the indication that the amendments to the claims submitted with the Reply filed April 26, 2001, overcome the rejection under 35 U.S.C. §102 based on the disclosure of Thomson et al., WO 93/12129 ("the Thomson reference"). The rejection under §103 has been maintained with respect to the group adamantyl, however, because this group is allegedly not disclosed in Applicants' priority documents. Although Applicants believe that adamantoyl groups are fully supported by the disclosure of "alkyl" in the earliest priority document at column 4, line 44, the Advisory Action fails to appreciate the more fundamental point that adamantyl groups are neither taught nor suggested by the Thomson reference, *regardless of the claim of priority*.

Although the earlier Office Actions of record alleged that Applicants' claims would have been obvious in view of the combined teachings of the Thomson reference and certain other references, the technical reasoning as to why one of ordinary skill in the art would have been motivated to prepare adamantoyl groups in particular has never been articulated. Indeed, none of the cited secondary references so much as mention adamantyl groups or derivatives thereof. Absent any evidence in this regard, Applicants fail to appreciate the skilled artisan would have been impelled to modify the Thomson reference to produce such groups. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §103.

The Advisory Action also maintains the rejection to claims 23, 24, and 39-52 under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. Applicants have pointed out

throughout prosecution that there is no reason to believe that one of ordinary skill in the art would not be able to practice the claimed methods to some measurable extent. Nevertheless, the Examiner continues to mistakenly believe that the specification must enable the therapeutic application of the claimed invention. Significantly, the Examiner has never suggested, much less disputed, that the claimed methods would not work at all. Under such circumstances, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph, in view of these amendments.

Applicants submit that the foregoing constitutes a full and complete response to the Advisory Action of record, and that claims 15-52 are in condition for ready allowance. An early indication to that effect is, therefore, earnestly solicited.

Attached hereto is a marked-up version of the changes made to the specification by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Respectfully submitted,



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PATENT

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In The Specification:

The first full paragraph of page 1 has been amended as follows.

This patent application is a U.S. national filing that derives from International Patent Application PCT/US98/10804, filed on May 28, 1998, which claims priority to application Serial No. 08/864,765, filed on May 28, 1997 (now abandoned), which is a continuation-in-part of application Serial No. 08/595,387, filed on February 1, 1996 (now U.S. Patent No. 5,773,571), which is a continuation-in-part of Serial No. 08/054,363, filed on April 26, 1993 (now U.S. Patent No. 5,539,082).